

REMARKS

Applicant have considered and studied the Office Action dated August 10, 2004. Claims 1-22 are pending. Claims 1-22 are rejected. Each of the rejections presented in the Office Action have been traversed below. Applicant respectfully requests reconsideration of the application in light of the following remarks.

The present invention is directed to an apparatus and a method for displaying information transmitted from a gateway system for converting protocols of an external network and a local network for information exchange between the external network and the local network. A plurality of terminals are connected to the local network. An information server stores various information transmitted from the external network or local network. The information server transmits the information to each terminal in an on-hook status thereof after checking the on-hook status of the terminal. The information server displays the information on a display unit of the terminal.

Other aspects and variations of the present invention will be discussed (as relevant) below.

§ 103(a) Rejection

Claims 1-22 have been rejected under 35 USC § 103(a) as being unpatentable over Montalbano (US 5,838,775) in view of Scordato (US 4,881,259). Applicant traverses these rejections below.

A rejection under 35 U.S.C. 103 requires both (1) a suggestion of the prior art to make and use the claimed device and (2) that one skilled in the art would make a reasonable expectation of making and using the compositions or device, or in carrying out the claimed process. In the instant case, the cited references, either alone or in combination, meet neither of these requirements.

Cited References

Montalbano (US 5,838,775) discloses a user-selectable interface having selectable graphical elements. The selectable graphical elements represent numbers on a telephone keypad for a screen telephone (Col. 1, lines 65-67). The screen telephone is connected to a network such as the public switched telephone network (PSTN) or a data network such as the Internet (Col 2, lines 1-5). The interface in Montalbano can be tailored by a user to correspond to services to which the user has subscribed to. A networked interface platform receives a

request for an interface from the screen phone. When the interface platform receives an interface request, it retrieves the appropriate interface from the interface adjunct platform and sends it to the requesting screen phone for display to the user. As stated in the Office Action, Montalbano fails to disclose verifying a terminal has an on-hook status before sending information to the terminal.

Scordato (US 4,881,259) discloses an integrated phone answering machine and cordless telephone base unit (Col. 2, lines 45-55). Scordato integrates the base unit of a cordless telephone with a telephone answering machine so that a user may actuate his remote handset unit from "standby" to "talk" (Col. 18, lines 25-55). As stated in the Office Action, Scordato discloses a phone with an on-hook and an off-hook status. The on-hook and the off-hook function of Scordato refers to (as shown in Figs. 7A-7C) the option for a user to screen telephone calls (Col. 18, lines 25-55). The user can actuate his remote handset from "standby" to "talk" to take a call now.

Claims 1 and 10

The Examiner rejected claims 1 and 10 stating "one of ordinary skill in the art at the time of Applicant's invention would have clearly recognized that it is quite advantageous for the screen phone disclosed by Montalbano to have an on-hook/off-hook status control. It is for this reason that one of ordinary skill in the art would have been motivated to incorporate Scordato's on-hook/off-hook status control with Montalbano's screen phone so that information sent to Montalbano's phone would never be lost." However, the Montalbano and the Scordato' devices are directed to entirely different inventions and there is no motivation provided by either reference to modify the Montalbano device by the teachings of Scordato.

It is well settled that a reference must provide some motivation or reason for one skilled in the art (working without the benefit of the Applicant's specification) to make the necessary changes in the disclosed device. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984).

The Examiner bears the burden of establishing the existence of either 1) some objective teaching in the prior art or 2) knowledge generally available to one of ordinary skill in the art which would lead that individual to change the primary reference. In re Jones, 21 USPQ2d 1941, 1943-44 (Fed. Cir. 1992). Section 103 does not allow the Examiner to engage in a

picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. In re Wesslau, 147 USPQ 391 (CCPA 1975). As the CAFC has said, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems v. Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984).

It is noted, as explained above, Montalbano is directed to a user selectable interface and Scordato is directed to an integrated telephone answering machine and cordless base unit. Furthermore, it is noted that Montalbano teaches an interface having multimedia features selected by a user to solve problems associated with prior art interfaces having non-uniform formats that are difficult to use by a user. Scordato solves problems associated with a conventional telephone and answering machine not being integrated into one unit. Scordato teaches a solution to a call-screening problem. Thus, there is no suggestion in this combination of references how to implement the apparatus of claims 1 and 10 which recite, among unique limitations, "an informational server ... transmitting the information to each terminal in an on-hook status therefore after checking the on-hook status of the terminal" Accordingly, it is respectfully submitted that Montalbano and Scordato are directed to overcoming completely different disadvantages identified for completely different prior art.

Therefore, one ordinarily skilled in the art at the time the invention was made would not have been motivated to modify the Montalbano invention with the teachings of Scordato to prevent loss of data sent to the phone of Montalbano when off. It is respectfully submitted that (for this reason alone) the combination of references is improper and that claims 1 and 10 are patentable.

In addition, one skilled in the art would not have a reasonable expectation of obtaining the apparatus of claims 1 and 10 from Montalbano in view of Scordato. Montalbano discloses a user-selectable interface but does not disclose (as stated in the Office Action) the limitation of claims 1 and 10 of "checking the on-hook status of the terminal". Scordato discloses the on-hook and the off-hook function (as shown in Figs. 7A-7C) for a user screening telephone calls. In contrast to claims 1 and 10 of the present invention, the telephone/answering machine in Scordato receives telephone calls whether in an on-hook or off-hook status. In contrast, claims 1 and 10, among other novel limitations, recite, "...an informational server for storing various information transmitted ... transmitting the information to each terminal in an on-hook status thereof after checking the on-hook status". In other words, the information server 220

(see Fig. 2 of Applicant's specification) stores the various information. The terminals described in claims 1 and 10 (of the Applicant's application) only receive information (advertisements, guide, bulletins, etc...) when the terminal is in an on-hook status after checking the terminal status.

Thus, a reasonable person would not expect the combination of the Montalbano user-selectable interface with the Scordato integrated telephone/answering machine for screening calls would result in the present invention claims 1 and 10 novel limitations. Thus, for this reason alone, the rejection of claims 1 and 10 should be withdrawn and claims 1 and 10 are patentable.

Claims 2 and 11

The Examiner rejected claims 2 and 11 stating "Montalbano fails to teach the use of Internet phone protocols for data communication when using a PC phone or Internet phone. However, the use of Internet protocols is deemed to be inherent to the Montalbano system because in order for the PC phones and Internet phones to be operative for data communication they must have Internet protocols".

It is respectfully submitted that the Examiner has not established the burden of proof necessary for establishing inherency outside of using the Applicant's disclosure. Thus, the claim 2 and 11 are not taught, suggested, nor motivated by Montalbano, even in view of Scordato and claims 2 and 11 are patentable.

Furthermore, Claims 2 and 11 being dependent on claims 1 and 10, in addition, are solely patentable for any of the same reasons as discussed for claims 1 and 10.

Claims 3 and 12

The Examiner has rejected claims 3 and 12 stating "Montalbano teaches a memory means for storing information transmitted from the information server, and a control means for controlling the storing of the transmitted information in memory means of the terminal (Col. 2, lines 15-18).

However, Col. 2, lines 15-18 states "[t]he present invention includes a database connected to the screen phone. The screen phone database stores the interfaces send from the interface platform to the screen phone." There is no mention of a control means for controlling the storing of transmitting information in memory means of the terminal. Thus, it is respectfully submitted that the Examiner has failed to establish that the limitation in claims 3 and 12 is taught, suggested, nor motivated by Montalbano even in view of Scordato. The Applicant respectfully submit that for this reason alone claims 3 and 12 are patentable.

Furthermore, claims 3 and 12 being dependent on claims 1 and 10 respectively, are patentable solely for all the same reasons as claims 1 and 10.

Claims 4 and 13

The Examiner has rejected claims 4 and 13 stating "Montalbano fails to teach a control means for judging the call status of the terminal. However, Scordato discloses a phone with an on-hook and an off-hook status. "

However, the Examiner has failed to cite a reference that teaches, suggest, or motivates the limitation "a control means for judging the call status of the terminal". Scordato teaches, suggest, or motivates on-hook or off-hook state, which state refers to a telephone call screening process (not the call status of the terminal as stated in the Office Action). In Scordato, the call screening process allows a user to listen to an incoming call. Based on a user input, the user can answer the call now or at a later time.

Thus, claims 4 and 13 are not taught, suggested, nor motivated by Montalbano even in view of Scordato and claims 4 and 13 are patentable.

Furthermore, claims 4 and 13 depending on claims 1 and 10 are patentable solely for all the same reasons as claims 1 and 10.

Claims 5 and 14

The Examiner has rejected claims 5 and 14 stating "[o]ne of ordinary skill in the art at the time of the Applicant's invention would have clearly recognized that it is quite advantageous for the screen phone taught by Montalbano to have an on-hook/off-hook status indicator. It is for this reason that one of ordinary skill in the art at the time of the Applicant's invention would have been motivated to incorporate Scordato's on-hook/off-hook status with Montalbano's screen phone so that information sent to Montalbano would not be lost."

However, the Examiner has failed to cite a reference that teaches, suggest, or motivates combining the references above. Furthermore, there is no reasonable expectation that the combination of the references will produce the claimed invention because Scordato teaches, suggest, or motivates on-hook or off-hook state, which state refers to a telephone call screening process (not the call status of the terminal as stated in the Office Action) as to whether a user will answer the call now or later.

Thus, for either of these reason discussed above, claims 5 and 14 are not taught, suggested, nor motivated by Montalbano even in view of Scordato and claims 5 and 14 are patentable.

Furthermore, claims 5 and 14 depending on claims 1 and 10 are patentable solely for all the same reasons as claims 1 and 10.

Claims 6 and 15

Claims 6 and 15, depending on claims 1 and 10, are patentable for all the same reasons as 1 and 10.

Claims 7 and 16

For analogous reasons as those presented in relation to Claims 3 and 4 above, Montalbano and Scordata, either alone or in combination, fail to teach or suggest the apparatus of the present invention as set forth in claims 7 and 16. Accordingly, it is respectfully submitted that claims 7 and 16 would not have been obvious to one skilled in the art at the time the invention was made, even in view of the combination of Montalbano and Scordata, and claims 7 and 16 are patentable.

Claims 9 and 18

For analogous reasons as those presented in relation to claims 3 and 4 above, Montalbano and Scordata, either alone or in combination, fail to teach or suggest the apparatus of the present invention as set forth in claims 9 and 18. Accordingly, it is respectfully submitted that claims 9 and 18 would not have been obvious to one skilled in the art at the time the invention was made, even in view of the combination of Montalbano and Scordata, and claims 9 and 18 are patentable.

Claim 19

For analogous reasons as those presented in relation to claims 1 and 5, Montalbano and Scordata, either alone or in combination, fail to teach or suggest the method of the present invention as set forth in claim 19. Accordingly, it is respectfully submitted that claim 19 would not have been obvious to one skilled in the art at the time the invention was made, even in view of the combination of Montalbano and Scordata, and claim 19 is patentable.

Claim 20

For analogous reasons as those presented in relation to claims 1 and 5, Montalbano and Scordata, either alone or in combination, fail to teach or suggest the method of the present invention as set forth in claim 20. Accordingly, it is respectfully submitted that claim 20 would

not have been obvious to one skilled in the art at the time the invention was made, even in view of the combination of Montalbano and Scordata, claim 20 is patentable.

Claim 21

For analogous reasons as those presented in relation to claims 19 and 20, Montalbano and Scordata, either alone or in combination, fail to teach or suggest the method of the present invention as set forth in claim 21. Accordingly, it is respectfully submitted that claim 21 would not have been obvious to one skilled in the art at the time the invention was made, even in view of the combination of Montalbano and Scordata, and claim 21 is patentable.

Claim 22

For analogous reasons as those presented in relation to claims 1 and 5, Montalbano and Scordata, either alone or in combination, fail to teach or suggest the method of the present invention as set forth in claim 22. Accordingly, it is respectfully submitted that claim 22 would not have been obvious to one skilled in the art at the time the invention was made, even in view of the combination of Montalbano and Scordata, and claim 22 is patentable.

CONCLUSION

No amendment made was related to the statutory requirements of patentability. No amendment made was for the purpose of narrowing the scope of any claim. Applicant respectfully request that the application is in the condition for allowance.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

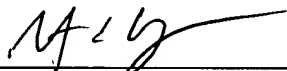
LEE, HONG, DEGERMAN, KANG & SCHMADEKA, P.C.

Date: November 4, 2004

Customer No. 035884

801 S. Figueroa Street, 14th Floor
Los Angeles, California 90017
Telephone: 213-623-2221
Facsimile: 213-623-2211

By: _____


Robert Edward Kasody
Registration No. 50,268
Jonathan Y. Kang
Registration No. 38,199
Attorneys for Applicant